

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. 8,071,092

Patent Application No. 09/589,288

Confirmation No. 1519

Applicants/Patentees: Yu et al.

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TC/AU: 1647

Examiner: Bridget E. Bunner

Docket No.: 702041 (Client Reference No. PF343P3C5)

Customer No.: 73326

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF THE DECISION ON APPLICATION
FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)**

Sir:

Patentees hereby request reconsideration of the “Decision on the Application For Patent Term Adjustment (37 C.F.R. § 1.705(d)) and Statement Of The Correct Patent Term Adjustment And Basis Therefor Under 37 C.F.R. § 1.702” mailed on February 28, 2012 (hereinafter “the Decision”).

In the “Application For Patent Term Adjustment (37 C.F.R. § 1.705(d)) and Statement Of The Correct Patent Term Adjustment And Basis Therefor Under 37 C.F.R. § 1.702” filed on February 6, 2012, Patentees requested, *inter alia*, reconsideration of the period of B delay calculated by the USPTO for the referenced patent on the basis that the prosecution of the application underlying the referenced patent did not include any time consumed by appellate review. Specifically, Patentees argued, *inter alia*, that the USPTO’s patent term adjustment calculation improperly includes a reduction in the period of B delay of 112 days for the period beginning on February 12, 2003, the date on which a Notice of Appeal was filed, and

ending on June 3, 2003, the date of mailing of an action under 35 U.S.C. § 132. Patentees therefore requested that the period of B delay should be corrected by increasing the period of B delay by at least 112 days. See the Application For Patent Term Adjustment (37 C.F.R. § 1.705(d)) and Statement Of The Correct Patent Term Adjustment And Basis Therefor Under 37 C.F.R. § 1.702 filed on February 6, 2012.

In the Decision mailed on February 28, 2012, the USPTO dismissed Patentees request to increase the period of B delay by at least 112 days. In particular, the USPTO indicated on page 8 of the Decision that:

“The period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See 35 U.S.C. 154(b)(1)(B)(ii). An appeal to the Board of Patent Appeals and Interferences commences with filing of a notice of appeal. See 35 U.S.C. 143(a). Generally, an appeal to the Board of Patent Appeals and Interferences ends with either (1) a Board decision, (2) the examination reopening prosecution and issuing another Office action, or (3) the applicant filing a request to withdraw the appeal and reopen prosecution (e.g. the filing of a request for continued examination).”

The Office also indicated that “[t]o the extent that the final rule on *Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review* revises the interpretation of appellate review applied in this decision, Patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the date of the final rule to file a request for reconsideration.” See page 9 of the Decision.

The USPTO published the Final Rule regarding the Revision of Patent Term Adjustment Provisions Relating to Appellate Review on August 16, 2012 (hereinafter “the Final Rule”). The Final Rule revises the interpretation of appellate review applied in the Decision. More specifically, the Final Rule changes the rules of practice to indicate that the period of appellate review under the patent term adjustment provisions of 35 U.S.C. § 154(b)(1)(B) begins when jurisdiction over the patent application passes to the Patent Trial and Appeal Board (the Board), rather than the date on which a Notice of Appeal to the Board is filed. Final Rule, 77 Fed. Reg. 49354, 49355 (Aug. 16, 2012).

As set forth in the Final Rule, 37 C.F.R. § 1.703(b)(4) has been amended to define the period of delay as “[t]he number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under § 41.35(a) of this chapter and ending on the date that jurisdiction by the Patent Trial and Appeal Board ends under § 41.35(b) of this chapter of the date of the last decision by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, whichever is later.” Final Rule, 77 Fed. Reg. at 49360.

Under the Final Rule, the period of delay calculated under 37 C.F.R. § 1.703(b)(4) for the referenced patent is 0 days because the filing of the Notice of Appeal did not result in jurisdiction over the application passing to the Board. Accordingly, the patent term adjustment calculation for the referenced patent should *not* include a reduction in the period of B delay of 112 days, thereby increasing the period of B delay by 112 days.

The Final Rule also states that “[t]he Office will also apply the changes to § 1.703 in this final rule in any timely patent term adjustment reconsideration proceeding that is initiated on or after September 17, 2012.” Final Rule, 77 Fed. Reg. at 49356. Accordingly, Patentees are timely initiating this request for reconsideration of the Decision within one month from the September 17, 2012 effective date of the Final Rule.

In view of the foregoing, Patentees hereby request that the USPTO reconsider the Decision mailed on February 28, 2012, and correct the period of B delay for the referenced patent to include at least 542 days (i.e., 430 days + 112 days) in view of the Final Rule.

Patentees also note that a civil action was timely filed in the United States District Court for the Eastern District of Virginia with respect to the referenced patent seeking correction of the PTA calculation errors identified in the “Application for Patent Term Adjustment (37 C.F.R. § 1.705(d)) and Statement of the Correct Patent Term Adjustment and Basis Therefor Under 37 C.F.R. § 1.702” filed on February 6, 2012 for the referenced patent.

It is believed that there is no charge for this request since the USPTO invited Patentees to file this request for reconsideration after the date of the Final Rule. However,

the Commissioner is hereby authorized to charge any fee that may be required to Deposit
Account No. 12-1216.

Respectfully submitted,



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